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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,149	02/08/2001	Damian Hajduk	1012-123D2(99-90DIV2)	4223

7590 03/10/2004

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EXAMINER

TRAN, MY CHAU T

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/779,149		HAJDUK ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	MY-CHAU T TRAN		1639	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 49-55 and 59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-55, and 59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

**Note:** The examiner for your application in the PTO has changed. However, the Group and/or Art Unit location of your application in the PTO is remained the same, which is Group Art Unit 1639.

#### ***Status of Claims***

1. Applicant's amendment filed 10/21/2003 is acknowledged and entered. Claims 49-55 are amended by the amendment. Claim 59 is added by the amendment.
2. Claims 49-55, and 59 are pending.

#### ***Terminal Disclaimer***

3. The terminal disclaimer filed on 9/15/2003 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US Patent No. 6,182,499, 6,438,497 B1, and 6,393,859 B1 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Withdrawn Rejections***

4. The previous non-statutory double patenting rejections of US Patent No. 6,182,499, 6,438,497 B1, and 6,393,859 B1 for claims 49-55 has been withdrawn in view of applicant's terminal disclaimer.

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5. The previous rejection under 35 USC 102(e) as being anticipated by M<sup>c</sup> Farland et al. (US Patent 6,182,499) for claims 49-55 has been withdrawn in view of applicant's amendments of claims 49-55 and arguments.

6. The previous rejection under 35 USC 102(e) as being anticipated by Mansky et al. (US Patent 6,438,497) for claims 49-55 has been withdrawn in view of applicant's amendments of claims 49-55 and arguments.

7. The previous rejection under 35 USC 102(e) as being anticipated by Matsiev et al. (US Patent 6,393,895) for claims 49-55 has been withdrawn in view of applicant's amendments of claims 49-55 and arguments.

8. Claims 49-55, and 59 are treated on the merit in this Office Action.

***Maintained Rejections***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 49-55, and newly added claim 59 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a

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gap between the elements. See MPEP § 2172.01. The omitted elements are elements that link perturbation of materials with the response monitored and screening. As written, the present claims do not provide enough information linking the elements of screening, perturbing, and monitoring for one skilled in the art to determine what would infringe on the claims. For example, a plurality of beakers containing different liquids being stirred on different stirring plates being monitored (to see if a solute is dissolved or not), for example, appears to read on present claim 49 but does not appear to be applicants' invention. Claims 50 and 51 provide no element linking measurement of forces exerted by probes and screening. Claim 52 provides no element linking the recited physical properties to a response. Claim 50 recites measuring forces exerted on the probes by the material samples "as functions of displacement between the probes and the materials". It is not clear how a force can be measured if the sample is displaced from (i.e. not in contact with) the probes.

### ***Response to Arguments***

12. The amended Claim 49 would not overcome the rejection under 35 U.S.C. 112, second paragraph, because there is still not enough information linking the elements of screening, perturbing, and monitoring for one skilled in the art to determine what would infringe on the claims. The amended Claim 49 only links the elements of perturbing, and monitoring wherein the claimed method includes the element of screening.

However, the amended Claims 50-52 has overcome the rejection under 35 U.S.C. 112, second paragraph. Thus the rejection is maintained for claims 49-55 and newly added claim 59 because the rejection for independent claim 49 is maintained.

***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T TRAN whose telephone number is 571-272-0810. The examiner can normally be reached on M: 8:00-2:30; Tues-Thur: 7:30-5:00; F: 8:00-3:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW WANG can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct

March 8, 2004



**ANDREW WANG**  
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